

Application No.: 10/047,929
Page 4

Attorney Docket No.: J38.2P-9535-US02

Remarks

In the Office Action dated May 28, 2003 claims 2 and 4-6 were rejected under 35 U.S.C. 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1-3 were rejected under 35 U.S.C. 103(a) as being unpatentable over Lisowski (US 5,937,473) in view of Urie, Jr. et al (US 5,505,154). Claim 4-6 were rejected under 35 U.S.C. 103(a) as being unpatentable over the modified invention of Lisowski and further in view of Nunziato (US 3,993,013).

In the interview with the Examiner on June 19, 2003, we discussed the 103 rejection based on the bristles of Urie constituting tines. I certainly disagreed with this characterization of the bristles of Urie and felt there was a substantial difference between a bristle and a tine. We then discussed additional limitations that might be included in the claims. Protuberances on the ends of the tines were one option as well as each tine being within the arc of curvature of the rod. The Examiner indicated that either of these could very well overcome the objections he had in light of the prior art, but further indicated that an additional search may be necessary. Claims 7-9 have been added to claim the limitations that are allowable over the prior art as discussed with the Examiner.

The rejections will be addressed under headings consistent with the paragraph numbering in the Office Action. Claims 7-9 have been added and do not introduce new matter.

2-6

In the Office Action dated May 28, 2003 claims 2 and 4-6 were rejected for indefiniteness under 35 U.S.C. 112, second paragraph. The Office Action asserts the limitation "the ridged grip handle" in claim 2, "the tines" in claim 4, and "the handle grip end" in claim 5 does not have sufficient antecedent basis for the limitation in the claim. Claims 2, 4, and 5 have been amended to address the antecedent basis issue. Applicant respectfully requests that the indefiniteness rejection be withdrawn.

Application No.: 10/047,929
Page 5

Attorney Docket No.: J38.2P-9535-US02

7-9

Claims 1-3 were rejected under 35 U.S.C. 103(a) as being unpatentable over Lisowski (US 5,937,473) in view of Urie, Jr. et al (US 5,505,154). The Office Action asserts that Lisowski teaches all the claim limitations of claims 1-3 except that the tines are in a plane substantially containing the arc of curvature of the rod. The Office Action states that Urie provides this missing limitation by asserting that it would be obvious to replace the rake head of Lisowski with the brush of Urie and that the bristles of Urie constitute the tines as claimed in claim 1.

Regarding the combination of two references for a finding of obviousness, the Federal Circuit has stated that a prima facie case of obviousness has not been established if:

- 1) The claimed invention and the references must be considered as a whole and suggest the desirability and the obviousness of making the combination.
 - 2) A and B could not or would not be physically combined in an operative fashion to produce the desired result by a person of ordinary skill without use of the patentee's teachings.
 - 3) The intended purpose or function of either A or B, or both, is destroyed by their combination.
 - 4) No suggestion why or reasons or motivation for combining A and B appears explicitly or implicitly in either A or B, or in combination.
- Hodosh v. Block Drug Co.*, 786 F.2d 1136, 229 USPQ 182, 187 (Fed. Cir. 1986).

With these principles as a guide, Applicant points out that when looking at the instant invention as a whole, one advantage is that the tool lies flat against the ground or the side of the boat because the tines project substantially out from the rod in a plane substantially containing the arc of curvature of the rod. In addition the tool is used primarily for the removal of weeds and/or debris from grates, anchors, propellers, motors and platforms attached to or a part of aquatic vehicles.

It is believed that the combination of references given in the Office Action fails because the instant invention is not being looked at as a whole. The combination of Lisowski and Urie would result in a device that neither lies flat on the floor or wall nor would it effectively

Application No.: 10/047,929
Page 6

Attorney Docket No.: J38.2P-9535-US02

remove weeds and debris. The brush of Urie has a width which would extend beyond the plane substantially containing the arc of curvature of the tool. In addition, the bristles of Urie are not capable of removing weeds and/or debris in the inventive manner the tines of the instant invention teach. Furthermore, the instant invention is not for the cleaning of the boat hull as is the purpose of the Urie reference. The instant invention is for the mechanical removal of debris from grates, anchors, and such; not boat hull cleaning.

In further addition, combining the brush head of Urie with Lisowski destroys the intended purpose or function of Lisowski (i.e. clearing debris from an intake) in a manner similar to the manner it would destroy the purpose and function of the instant application. The brush head of Urie is simply ineffective in clearing debris from an intake or grate.

Furthermore, no suggestion why or reasons or motivation for combining Urie and Lisowski appears explicitly or implicitly in either Urie or Lisowski.

Finally, it cannot be emphasized strongly enough that a bristle is not a tine. This is even more evident to one skilled in the art. One skilled in the art recognizes that a brush is used for purposes of cleaning a boat hull and that a tined implement is necessary for properly performing the function of removing weeds and debris from grates, anchors, propellers, motors and platforms. The American Heritage College Dictionary defines a tine as: 1) a branch of a deer's antlers. 2) A prong on an implement such as a fork or pitchfork. In contrast, a bristle is defined merely as "a stiff hair". It is inappropriate to extend the common meaning of the word "bristle" into the common meaning of the word "tine".

For these reasons, Applicant respectfully requests that the 103 obviousness rejection in regard to claims 1-3 be withdrawn.

10

In the Office Action dated May 28, 2003 claims 4-6 were rejected under 35 U.S.C. 103(a) as being unpatentable over the modified invention of Lisowski and further in view of Nunziato (US 3,993,013). For the reasons given above under heading "7-9", the modified invention of Lisowski is inappropriate. Thus, the combination of Nunziato with this same

Application No.: 10/047,929

Attorney Docket No.: J38.2P-9535-US02

Page 7

modified invention is also inappropriate. Applicant respectfully requests that the 103 obviousness rejection in regard to claims 4-6 be withdrawn.

Conclusion

In light of the above, withdrawal of the rejections is requested. Applicant believes that pending claims 1-9 are in condition for allowance. Early notification of such is earnestly solicited.

Respectfully submitted,

VIDAS, ARRETT & STEINKRAUS

Date: April 28, 2003

By: Brendan Babcock
Brendan Babcock
Registration No. 50,705

Suite 2000
6109 Blue Circle Drive
Minnetonka, MN 55343-9185
Telephone No.: (952) 563-3000
Facsimile No.: (952) 563-3001
F:\WPWORK\bb\9535_AMD_427-03

OFFICIAL
FAX RECEIVED
AUG 29 2003
GROUP 3600